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| 09/575,181      | 05/23/2000  | Paul Lapstun         | NPA075US            | 9167             |

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SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

MILLIN, VINCENT A

ART UNIT PAPER NUMBER

3624

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/575,181

Applicant(s)

LAPSTUN ET AL.

Examiner

Sandra Snapp

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

This Office Action is in response to the Amendment filed on 11-03-03. Currently claims 1-65 are pending in the application. New claims 60-65 were added with the Amendment of 11-03-03.

***Specification***

The objection to the disclosure has been successfully overcome with the submission of the Amendment on 11-3-3, as such the objection is herein withdrawn.

***Claim Rejections - 35 USC § 101***

The rejection of claims 1-28, 32, 36-46, and 48 as being rejected under 35 U.S.C. 101 has been successfully overcome by the Amendment of 11-3-3 and is herein withdrawn.

***Claim Rejections - 35 USC § 112***

The rejection of claims 8-17, 23, 26, 33-42, and 44-48 as being rejected under 35 U.S.C. 112, second paragraph, has been successfully overcome by the Amendment of 11-3-3 and is herein withdrawn.

However, claims 1, 4, 60, 61 & 64 are now herein rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because the term "substantially" is vague and

indefinite. One cannot determine the metes and bounds of the claimed invention when the term “substantially” is used.

***Claim Rejections - 35 USC § 102***

The rejection of claims 1-22, 24-27, 29- 49, 51 and 55 as being rejected under 35 U.S.C. 102(b) by the Perazza patent (5,326,959) is herein withdrawn in view of the rejection stated below.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

*Claims 1-27, 29-31, 32-41, 43-45, 47, 49, 51, 55 and 60-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent (US 5,326,959) in view of the Mallicoat patent (US5,248,856).*

The Perazza patent discloses a method of enabling bill payment of bills, and related system and forms, comprising the steps of:

providing a printed form to the user, the printed form containing information relating to a payment transaction, and including coded data indicative of an identity of the form and of at least one reference point of the form, the information and the coded data of the form having been printed substantially simultaneously (col. 11, lines 1-22 and col. 16, lines 29-54),

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receiving, in a computer system, indicating data from a sensing device operated by the user, the indicating data being indicative of an identity of the form and of a position of the sensing device relative to the form and of the identity of the user, the indicating data having been generated by the sensing device using at least some of the coded data it sensed when placed in an operative position relative to the form (col. 16, lines 29-54 and col. 11, lines 1-22), and

identifying, in the computer system and from the indicating data, at least one parameter relating to the bill paying transaction (col. 16, lines 24-54) (claims 1, 4, 5, 29, 32, 33, 49, 60, 61, 62, 63, 64, 65);

the at least one parameter relating to the bill paying transaction is associated with at least one zone of the form and in which the method includes identifying, in the computer system and from the zone indicated by the position of the sensing device as indicated by the indicating data, said at least one parameter (col. 16, lines 29-48) (Claims 2 and 30);

the coded data being indicative of at least one parameter of the bill paying transaction, wherein the indicating data includes parameter information indicative of the at least one parameter of the bill paying transaction, the sensing device having determined the parameter information using at least some of the sensed coded data (col. 10, lines 29-48) (Claims 6 and 34);

at least one parameter is an action parameter of the bill paying transaction, the method including effecting, in the computer system, an operation in respect of the action parameter (col. 16, lines 28-48) (Claims 8 and 36);

the action parameter of the bill paying transaction is selected from the group consisting of:

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requesting information relating to a bill, initiating bill payment, resetting the form, electronically forwarding a bill, paying a bill, printing a bill, canceling a bill payment, listing due bills, listing or adding billers, listing, adding or removing payment methods and listing or removing failed bills (col. 16, lines 28-48) (Claims 9 and 37);

at least one parameter is an option parameter of the bill paying transaction, the method including identifying, in the computer system, that the user has entered a hand-drawn mark by means of the sensing device and effecting, in the computer system, an operation associated with the option parameter (col. 16, lines 28-63) (Claims 10 and 36);

the option parameter is associated with at least one of: a payment method, card type, bill payment line, autopay option, and account type (col. 16, lines 28-63) (Claims 11 and 38);

the at least one parameter is a text parameter of the bill paying transaction, the method including identifying, in the computer system, that the user has entered handwritten text data by means of the sensing device and effecting, in the computer system, an operation associated with the text parameter (col. 16, lines 28-63) (Claims 12 and 36);

converting, in the computer system, the handwritten text data to computer text (col. 16, lines 28-63) (Claim 13);

the text parameter is associated with at least one of: payment limit, account name, account number, cardholder name, card expiry date, autopay limit, payment amount and payment date (col. 16, lines 28-63) (Claims 14 and 39);

the at least one parameter is an authorization parameter of bill paying transaction, the method including identifying, in the computer system, that a payer has entered a handwritten

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signature by means of the sensing device, and effecting, in the computer system, an operation associated with the authorization parameter (col. 16, lines 28-63) (Claims 15 and 36);

verifying that the signature is that of the payer (col. 16, lines 55-63) (Claim 16);

the authorization parameter is associated with payment authorization, listing due bills, listing all bills, listing billers, listing payment methods, listing failed bills, adding a payment method and adding a biller (col. 16, lines 28-63) (Claims 17 and 40);

the indicating data relates to a request, that a bill be printed locally (col. 16, lines 53-65) (Claim 18);

a portion of the coded data is superimposed with a visual graphic, the visual graphic relating to the parameter associated with the portion (Fig. 2) (Claim 19);

the form is a bill (col. 1, lines 31-32) (Claims 20 and 41);

supplying the form as part of a product, such as a printed periodical, or its packaging (Abstract, bank product which is printed periodically) (Claims 21, 22 and 55);

retaining a retrievable record of each form generated, in a database, the form being retrievable using its identity as contained in the coded data (col. 16, lines 53-65) (Claims 24 and 47);

distribution of a plurality of the forms using convention mail (col. 3, lines 62-66) (Claim 25);

providing all required information relating to the bill paying transaction in the form to eliminate the need for a separate display device (col. 11, lines 62-65) (Claim 27);

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the form is a surface of the surface-defining means and in which the system includes a printer for printing the form prior to distribution to the user (col. 6, lines 53-65) (Claims 44 and 51);

the printer is configured to print the coded data at the same time as printing the form on the surface defining means (col. 6, lines 53-66) (Claim 45).

The Perazza patent discloses all the elements of the present invention except for the information and the coded data of the form having been printed substantially simultaneously (Claims 1, 4, 5, 29, 32, 33, 49, 60, 61, 62, 63, 64, 65). The information and coded data being printed simultaneously is merely non-functional descriptive material and is not functionally involved in the steps recited. The steps of the method would be performed the same regardless of whether the information and coded data were printed simultaneously or not. Thus, the descriptive material will not distinguish the claimed invention from the prior art in terms of patentability.

The Perazza patent also discloses all the elements of the claimed invention, as stated above, except:

interpreting, in the computer system, the movement of the sensing device as it relates to the at least one parameter (claims 1, 4, 5, 29, 32, 33, 49, 60, 61, 62, 63, 64, 65);

the indicating data includes movement data indicative of movement of the sensing device relative to the form, the sensing device having generated the movement data using at least some of the coded data, and



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wherein the at least one parameter is identified in the computer system by determining that the movement was at least partially within the at least one zone (Claims 3, 7, 31 and 35); and the sensing device contains an identification means which imparts a unique identity to the sensing device and identifies it as belonging to the user and in which the method includes monitoring, in the computer system, the identity (Claims 26 and 43).

The Mallicoat patent teaches:

interpreting, in the computer system, the movement of the sensing device as it relates to the at least one parameter (M - col. 7, lines 48-56) (claims 1, 4, 5, 29, 32, 33, 49, 60, 61, 62, 63, 64, 65);

the indicating data includes movement data indicative of movement of the sensing device relative to the form, the sensing device having generated the movement data using at least some of the coded data (M - col. 7, lines 48-56), and

wherein the at least one parameter is identified in the computer system by determining that the movement was at least partially within the at least one zone (P – col. 16, lines 29-48) (Claims 3, 7, 31 and 35); and

the sensing device contains an identification means which imparts a unique identity to the sensing device and identifies it as belonging to the user and in which the method includes monitoring, in the computer system, the identity (M – col. 6, line 66 through col. 7, line 9) (Claims 26 and 43). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent with the teachings of the Mallicoat patent so as to provide a more accurate and informative reading from the bill.

*Claims 23, 42, 46 and 58 remain rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent as applied to claims 1, 4, 5, 29, 32 and 33 above, and further in view of the PCT application WO 99/50787 (XEROX).*

The Perazza patent discloses all the elements of the claimed invention, as stated above, except the data being invisible (claims 23, 46 and 58) and the sensing device having a marking nib (claim 42). The XEROX reference teaches the data being substantially invisible (page 8, lines 23-25) and the sensing device having a marking nib (505, page 14, lines 10-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to have substantially invisible data so as to interfere with other visible markings on the bill and to have a sensing device with a nib so that should marks be necessary on the bill, they can be made at the time of reading the bill with the sensing device.

*Claims 28 and 48 remain rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent as applied to claims 1, 4, 5, 29, 32 and 33 above, and further in view of the Japanese Patent Abstract 10194562 A.*

The Perazza patent discloses all the elements of the claimed invention, as stated above, except the binding of a multipage bill (claims 28 and 48). The Japanese patent abstract reference teaches the binding of multiple pages of the bill (Solution portion of Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to have a means of binding a bill having multiple pages so that the various pages will remain together and reduce the opportunity for them to become separated.

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*Claims 50, 52-54, 56, 57 and 59 remain rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent as applied to claim 49 above, and further in view of the Sekendur Patent (US 5,477,012).*

The Perazza patent discloses all the elements of the claimed invention, as stated above, except the sensing device generating time-varying information (claim 50); digital ink (claim 52); a wireless pen interface (claim 53); data from pen tilt (claim 54); data from dots (claim 56); a target area indicating corners (claim 57); and infrared absorbing media (claim 59). The Sekendur reference teaches the sensing device generating time-varying information (col. 1, lines 64-66); digital ink (col.3, lines 25-35); a wireless pen interface (col. 5, lines 1-10); data from pen tilt (col. 1, lines 64-66); data from dots (col. 4, lines 28-41); a target area indicating corners (col. 4, lines 45-59); and infrared absorbing media (col. 4, lines 25-27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to have the sensing device of Sekendur so as to provide more versatility to the scanning device already present in Perazza thereby allowing for various types of forms/bills to be processed using the same system.

#### ***Double Patenting***

The provisional double patenting rejection is herein withdrawn in view of the Terminal Disclaimer filed on 11-03-03. The Terminal Disclaimer submitted on 11-03-03 has been entered into the application.

#### ***Response to Arguments***

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Applicant's arguments with respect to the rejection based on 35 U.S.C. 102(b) have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

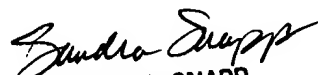
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Hoffman patent discloses sensing bio-metric data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

SS

  
SANDRA S. SNAPP  
PATENT EXAMINER  
GROUP 3600